

Application No. 10/636,014
Response dated: December 22, 2005
Reply to Office action of September 22, 2005

REMARKS

In response to the Office Action dated September 22, 2005, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-20 are pending in the present Application. Claims 1, 9, 17 and 18 are amended and Claims 2 and 10 are cancelled without prejudice, leaving Claims 1, 3-9 and 11-20 for consideration upon entry of the present amendments and following remarks. The Specification is amended to more clearly set forth the invention.

Support for the amendments can at least be found in the specification, the figures, and the claims as originally filed. No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections under 35 USC §112

Claim 19 is rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the preamble of Claim 19 does not match the preamble of preceding claims from which it depends.

In response, Applicant herein amends Claim 18 to provide proper preamble language and antecedent basis for Claim 19. Reconsideration and withdrawal of the relevant rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

Claims 1, 3-5, 7, 9 and 11-13 are rejected under 35 U.S.C. §102(b) as being anticipated by Brissier et al., U.S. Patent No. 4,815,605 (hereinafter "Brissier"). Applicant respectfully traverses.

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"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Amended Claims 1 and 9 recite, *inter alia*, "wherein the shell is made of a synthetic resin."

Brissier discloses that steel sheets 28 constitute the outer wall. (Col. 3, lines 48-53.) That is, Brissier does not disclose the shell is made of a synthetic resin of amended Claims 1 and 9.

Thus, Brissier does not disclose all of the limitations of amended Claims 1 and 9. Accordingly, Brissier does not anticipate Claims 1 and 9. Applicants respectfully submit that Claims 1 and 9 are patentably distinct over Brissier. Claims 3-5, 7 and 11-13 are also rejected over Brissier. However, these claims variously depend from Claims 1 and 9 and are thus correspondingly patentably distinct. Reconsideration and entry of the amendment is thus respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Regarding Claims 1, 3-5, 7, 9, 11-13 and 20

Claims 1, 3-5, 7, 9, 11-13 and 20 are rejected under 35 U.S.C. §103(a) as being obvious over Hembert, U.S. Patent No. 5,004,120 (hereinafter "Hembert") in view of Brissier. Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

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Hembert does not teach the shell is made of a synthetic resin of amended Claims 1 and 9. As discussed above, Brissier also does not teach this limitation of amended Claims 1 and 9 and therefore does not remedy the deficiencies of Hembert.

Thus, Hembert and Brissier, alone or in combination, do not disclose *all of the limitations* of amended Claims 1 and 9. Accordingly, *prima facie* obviousness does not exist regarding Claims 1 and 9 with respect to the Hembert and Brissier patents. Applicant respectfully submits that Claims 1 and 9 are not further rejected or objected and are therefore allowable. Claims 3-5, 7, 11-13 and 20 are also rejected over Hembert and Brissier. However, these claims variously depend from Claims 1 and 9 and are thus correspondingly allowable. Reconsideration and allowance of Claims 1, 3-5, 7, 9, 11-13 and 20 is respectfully requested.

Regarding Claims 6, 8 and 14-16

Claims 6, 8 and 14-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hembert and Brissier as applied to Claims 1 and 9 above, and further in view of Starling et al., U.S. Patent No. 4,573,603 (hereinafter "Starling"). Applicant respectfully traverses.

Claims 6, 8 and 14-16 variously depend from Claims 1 and 9. Dependent claim inherit all of the limitations of their parent claims. As discussed above, Hembert and Brissier do not disclose the shell is made of a synthetic resin of amended Claims 1 and 9. Starling also does not teach this limitation of Claims 6, 8 and 14-16 and therefore does not remedy the deficiencies of Hembert and Brissier.

Thus, Hembert, Brissier and Starling, alone or in combination, do not disclose *all of the limitations* of amended Claims 6, 8 and 14-16. Accordingly, *prima facie* obviousness does not exist regarding Claims 6, 8 and 14-16 with respect to the Hembert, Brissier and Starling patents. Applicant respectfully submits that Claims 6, 8 and 14-16 are not further rejected or objected and are therefore allowable. Reconsideration and allowance of Claims 6, 8 and 14-16 is respectfully requested.

Regarding Claims 2, 18 and 19

Claims 2, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Brissier in view of Matsuno et al., U.S. Patent No. 5,906,286 (hereinafter "Matsuno").

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Applicant respectfully traverses. The limitations of Claim 2 have been incorporated into amended Claim 1 and Claim 2 has been hereinabove cancelled, rendering the rejection for Claim 2 moot. Claim 18 (as amended) and Claim 19 depend from amended Claim 9 and inherit all of the limitations of Claim 9.

In the Office Action details on Page 6, Item 8, Matsuno is being relied upon to disclose the shell made of thermoplastic resin and the bottom portion 4 of Matsuno is being considered as disclosing the shell of the claimed invention. Applicant respectfully disagrees.

Matsuno discloses a container 101 having a mouth-and-neck portion 1, a shoulder portion 2, a barrel portion 3 and a bottom portion 4 formed by blow-molding resin. (Col. 7, lines 50-64 and Fig. 1.) The bottom portion includes various features such as a center 5, valleys 6 and feet 7. (*Id.*) That is, the bottom portion 4 is the container 101 and not any device, separate from the container, for protecting the container.

Additionally, as the bottom portion 4 is the container 101, the bottom portion 4 cannot be an element configured to envelope itself. Therefore, Matsuno does not disclose a shell made of a puncture-resistant material, shaped to envelope at least the entirety of the dome of the container, delimiting a space between an interior face of the shell and an exterior face of the wall of the container as claimed.

Thus, Brissier and Matsuno, alone or in combination, do not disclose *all of the limitations* of amended Claims 1 (now including the limitations of Claim 2) and 18 and Claim 19. Accordingly, *prima facie* obviousness does not exist regarding Claims 1, 18 and 19 with respect to the Brissier and Matsuno patents.

Additionally, Applicant respectfully contends that there exists no *motivation to combine* the references to teach the claimed invention.

Matsuno discloses a self-standing *container* that is blow molded using a resin. (Col. 7, lines 50-55.) Matsuno is silent as to any motivation or suggestion for providing a device in addition to the container, especially to protect the ends or the dome of the container. Matsuno does not disclose anything of a shell, but only of a container, as discussed above. That is, Matsuno discloses a vastly different invention in an unrelated technology for an unrelated purpose to the claimed invention. Therefore, there is *no motivation or suggestion* to provide the resin *container* of Matsuno with Brissier to teach the claimed invention.

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As further evidence of no motivation to combine Brissier and Matsuno, the invention of Matsuno cannot be removably mounted in a container such that the wall of the container can be periodically inspected as described in the Specification at page 4, lines 34-38. Matsuno has no removable parts that are applied to a container, as discussed above and claimed. That is, Matsuno does not function as the claimed invention and does not propose to address the same issues as the claimed invention, namely, protecting a container and being removably mounted. To the contrary, the primary focus of Matsuno is to provide a biaxially drawn container of which the whole bottom portion has a reduced thickness and a method of mass-producing self-standing containers having a petaloid-type bottom. (Col. 3, line 50 to Col. 4, line 6.) Therefore, there exists *no motivation or suggestion to modify or combine the references* to teach the claimed invention.

Since Brissier and Matsuno fail to teach or suggest all of the limitations of amended Claims 1 (now including the limitations of Claim 2) and 18 and Claim 19, are in vastly different fields of endeavor and function totally differently, one of ordinary skill at the time of Applicant's invention would not have a *motivation to modify or combine the references*, or a reasonable likelihood of success in forming the claimed invention by the Examiner's suggestion of modifying or combining the reference. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Thus, the requirements of *prima facie* obviousness are not met by the Examiner's suggestion to combine Brissier and Matsuno. Applicant respectfully submits that Claims 1 and 9 are allowable, as discussed above. Claims 18 and 19 are not further rejected or objected and are therefore allowable as depending upon allowable Claim 9. Reconsideration and allowance of Claims 18 and 19 is respectfully requested.

Regarding Claims 10 and 17

Claims 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hembert and Brissier as applied to Claim 9 above and further in view of Matsuno. Applicant respectfully traverses. The limitations of Claim 10 have been incorporated into amended Claim 9 and Claim 10 has been hereinabove cancelled, rendering the rejection for Claim 10 moot.

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Claim 17 (as amended) depends from amended Claim 9 and inherits all of the limitations of Claim 9.

In the Office Action details on Page 7, Item 9, Matsuno is being relied upon to disclose the shell made of thermoplastic resin and the bottom portion 4 of Matsuno is being considered as disclosing the shell of the claimed invention.

For all the reasons stated above, Hembert, Brissier and Matsuno do not at least disclose a shell made of a puncture-resistant material, shaped to envelope at least the entirety of the dome of the container, delimiting a space between an interior face of the shell and an exterior face of the wall of the container and the shell made of thermoplastic resin of amended Claims 9 (including the limitations of Claim 10) and 17.

As discussed above, Claim 9 is allowable. Applicant submits that Claim 17 is not further rejected or objected and is therefore allowable as depending upon allowable Claim 9. Reconsideration and allowance of Claim 17 is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

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In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By: Amy Bizon-Copp
Amy Bizon-Copp
Reg. No. 53,993
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115

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